

REMARKS

By this amendment, claims 11 and 12 have been amended. Claims 14-16 were withdrawn in Applicants' election, with traverse, of Group I, claims 1-13 in Applicants' reply filed on January 6, 2006. The specification has been amended to correct certain informalities. Accordingly, claims 1-13 are currently pending in the application, of which claim 1 is an independent claim.

Applicants appreciate acknowledgment of the claim for priority under 35 U.S.C. §119(a)-(d) and the filing of the certified copy of Korean Application No. 10-2002-0041169.

Applicants respectfully submit that the above amendments do not add new matter to the application and are fully supported by the specification.

In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Specification Objection

In the Office Action, the specification at pages 8 and 9 was objected to because phosphate and phosphorodiamidite are not phosphonate groups.

The specification has been amended to remove ethylene glycol methacrylate phosphate and correct the spelling of allyl tetraisopropylphosphonodiamidate.

Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants respectfully traverse this rejection for at least the following reasons.

The Examiner objected that it is unclear what the final product of the compound that contains phosphonate is, because the unsaturated hydrocarbon groups in claim 12 do not exist in the final product. However, polymerization generally occurs at the double bond included in the unsaturated hydrocarbon. Accordingly, P=O bonds in phosphonate remain in the final product after polymerization of the phosphonate. Also, the effect of the present invention is derived from the linear polymer having P=O bonds, not the phosphonate. Therefore it is important that the final product of the compound includes P=O bonds, not phosphonate.

Claim 12 has been amended to remove ethylene glycol methacrylate phosphate and correct the spelling of allyl tetraisopropylphosphonodiamidate. This amendment is made for the sole purpose of clarifying the phosphonate compounds, as recited in claims 12 and 13. This amendment is not made for the purpose of avoiding prior art or narrowing the claimed invention, and no change in claim scope is intended. Therefore, Applicants do not intend to relinquish any subject matter by these amendments. Applicants respectfully submit that claims 12 and 13, as amended, fully comply with the requirements of 35 U.S.C. § 112, second paragraph.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, second paragraph rejection of claims 12 and 13.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 9-11 and 13 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Japanese Patent Publication No. JP11-273731 issued to Naoki ("Naoki").

Applicants respectfully traverse this rejection for at least the following reasons.

In order for a rejection under 35 U.S.C. § 102(b) to be proper, a single reference must disclose every claimed feature. To be patentable, a claim need only recite a single novel feature that is not disclosed in the cited reference. Thus, the failure of a cited reference to disclose one or more claimed features renders the 35 U.S.C. § 102(b) rejection improper.

Naoki fails to teach or suggest each and every claimed feature of the present invention. More particularly, Naoki fails to teach or suggest

"A lithium secondary battery, comprising: a positive electrode...a negative electrode...a separator interposed between the positive and negative electrodes; and an electrolyte on the separator, wherein the electrolyte includes a non-aqueous organic solvent, a lithium salt, and a linear polymer having P=O bonds.

Rather, Naoki teaches a non-aqueous electrolyte rechargeable battery comprising a positive electrode 1, a negative electrode 2, a separator 3 interposed between the positive and negative electrodes, and an electrolytic solution 4 (See Figure 1, See [0031] and [0033]), but does not disclose nor suggest an electrolyte on the separator, wherein the electrolyte includes a non-aqueous organic solvent, a lithium salt, and a linear polymer having P=O bonds.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-4, 9-11 and 13. Claims 2-4, 9-11 and 13 depend from claim 1 and are allowable at least for this reason. Since none of the other prior art of record discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 1, and all the claims that depend therefrom, are allowable.

Rejections Under 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The examiner has failed to establish a prima facie case of obviousness. Assuming *arguendo* that the references may be combined and a reasonable expectation of success exists, the combined references do not disclose or suggest all of the claim limitations.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Naoki in view of U. S. Patent Publication No. 2002/0177027 issued to Yeager, *et al.* ("Yeager"). Applicants respectfully traverse this rejection for at least the following reasons.

As noted above, Naoki fails to teach or suggest each and every claimed feature of the present invention, as recited in claim 1. Yeager fails to cure the deficiencies of Naoki. Claim 12 depends from independent claim 1, and therefore is allowable for at least the aforementioned reasons.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 12. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that claim 12 is allowable.

Claims 1 and 5-8 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Naoki in view of Yeager and U.S. Patent No. 6,645,671 issued to Tsutsumi. Applicants respectfully traverse this rejection for at least the following reasons.

As noted above, Naoki fails to teach or suggest each and every claimed feature of the present invention, as recited in claim 1. Yeager and Tsutsumi fail to cure the deficiencies of Naoki. Claims 5-8 depend from independent claim 1, and therefore are allowable for at least the aforementioned reasons.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1 and 5-8. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claim 1, and all claims that depend therefrom, are allowable.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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